UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,161	09/29/2000	Brian G. Morin	19781	1080

25280 7590 06/04/2002

MILLIKEN & COMPANY
920 MILLIKEN RD
PO BOX 1926
SPARTANBURG, SC 29304

EXAMINER	
GUARRIELLO, JOHN J	

ART UNIT	PAPER NUMBER
1771	5

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/676,761	Morin et al.
Examiner	**Group Art Unit**
John Guarriello	1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 4/29/2000.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-9, 17-25 is/are pending in the application.

Of the above claim(s) 1-9 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 17-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s) # 4

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

15. The Examiner acknowledges the preliminary amendment submitted 9/29/2000, paper # 2.

16. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, drawn to Method of use , classified in class 134, subclass 104.1.

II. Claims 17-25, drawn to article, classified in class 442, subclass 408.

The inventions are distinct, each from the other because:

17. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In

the instant case the product as claimed can be used in a materially different process of using that product such as making of filters.

18. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

19. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

20. During a telephone conversation with Timothy J. Monahan on 5/6/2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 17-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9, Group I are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

22. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

23. Claims 19-21, 23, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the cited claims, 19-21, 23, 25 it is not clear what the "IEST-RP-CC004.2 ? 7.1" refers, since the instant specification is not clear under what parameters these tests or test were conducted.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daiber et al. 5,229,181.

Daiber describes cleanroom wiper made from continuous fabric, (column 3, lines 28-34), like polyester. Daiber describes the wiper is knit from polyester continuous filament yarn, (column 4, lines 16-19). Daiber describes where the fabric is heated to 460 degrees F, (column 4, lines 48-50). Daiber describes can be packaged, (column 4, lines 14-15). It is the Examiner's position that the polyester of the reference is only slightly different than the claimed article since no amounts of polyester are stated and no weight is specified, except a process limitation regarding heat treatment. Even though product-by-process claims are limited by and defined by the process,

determination of patentability is based on the product itself. The patentability of a product does not depend upon its method of production. If the product in the product-by-process claim is the same as or is obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process, see In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the heat set because it depends upon the material and this would be motivated by a desire to use less energy for the heat set purposes of the claimed invention, moreover it has been held that where the general conditions of a claim are disclosed in the prior at, discovering the optimum or workable ranges, in this case temperature for heat set, involves only routine skill in the art, In re Aller, 105 USPQ 233.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone

number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

John J. Guarriello:gj

Patent Examiner

May 15, 2002

May 24, 2002

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700